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**Datasheet for the decision  
of 21 January 2016**

**Case Number:** T 0201/14 - 3.3.07

**Application Number:** 05009760.9

**Publication Number:** 1719546

**IPC:** A61Q5/12, A61K8/34, A61K8/39,  
A61K8/41, A61K8/73, A61K8/86,  
A61K8/891

**Language of the proceedings:** EN

**Title of invention:**  
Hair conditioning composition

**Patent Proprietor:**  
Kao Germany GmbH

**Opponent:**  
Beiersdorf AG

**Relevant legal provisions:**  
EPC Art. 54, 56

**Keyword:**  
Novelty - novelty of use - second (or further) non-medical use  
Inventive step - (yes)

**Decisions cited:**  
G 0002/88, G 0006/88, G 0008/93



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Case Number: T 0201/14 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 21 January 2016**

**Appellant:** Beiersdorf AG  
(Opponent 2 ) Unnastrasse 48  
20253 Hamburg (DE)

**Respondent:** Kao Germany GmbH  
(Patent Proprietor) Pfungstädterstrasse 92-100  
64297 Darmstadt (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
9 December 2013 concerning maintenance of the  
European Patent No. 1719546 in amended form.**

**Composition of the Board:**

**Chairman** J. Riolo  
**Members:** D. Semino  
P. Schmitz

## Summary of Facts and Submissions

I. European Patent No. 1 719 546 was granted on the basis of 14 claims. It stemmed from European application No. 05 009 760.9 filed on 4 May 2005 and included in its granted form three independent claims, namely product claim 1, process claim 2 and use claim 14, whereby claim 2 read as follows:

"2. Process for increasing volume and body of hair characterised in that a conditioning composition comprising at least one hair conditioning compound in a cosmetically acceptable medium characterised in that it comprises additionally  
a- at least one first ethoxylated fatty alcohol with 1 to 3 ethoxy groups, and  
b- at least one second ethoxylated fatty alcohol with 4 to 20 ethoxy groups, at a total concentration of a and b 0.5 to of 10% by weight  
with the condition that first and second ethoxylated fatty alcohols have an alkyl chain length of 10 to 22 carbon atoms, wherein the first and second ethoxylated fatty alcohols are present at a weight ratio of 5:1 to 1:5 is applied onto shampooed hair and left on the hair for 1 to 20 min and rinsed of with water."

II. Two notices of opposition were filed in which revocation of the patent in its entirety was requested.

III. During opposition proceedings, the following documents *inter alia* were cited:

D1: WO-A-00/61066

D2: WO-A-2006/000257 (filed on 19 February 2005 and published on 5 January 2006)

D3: "The Volpos", datasheet, September 1994

D4: US-B-6 274 128

D6: US-A-4 725 433

IV. The decision of the opposition division concerning maintenance of the patent in amended form was announced at the oral proceedings on 7 November 2013. It was based on a set of claims filed as main request with letter of 2 May 2012 and on a description adapted during such oral proceedings.

The claims of the main request corresponded to the claims as granted with the deletion of claims 1 and 14. It included therefore a single independent claim 1, which corresponded to granted claim 2.

V. The decision of the opposition division, as far as relevant to the present decision, can be summarised as follows:

- a) The amendments of the claims fulfilled the requirements of Article 123(2) EPC and examples 2 to 7 could stay within the specification without causing clarity problems.
- b) In the lack of experimental evidence or convincing arguments about why the possibility of application to wet hair and the lack of the exact conditions during drying might influence the success of the claimed process, the requirement of sufficiency was considered to be met.
- c) While document D2 disclosed compositions as the ones used in the claimed process, it did not mention the increase in body of hair in relation to those compositions. Contrary to case T 304/08 where the process led to a product with specific

characteristics which made it possible a use thereof, in the present case the claim was directed to a process characterised by the application of a composition to the hair in order to achieve an effect. The feature "increasing volume and body of hair" was therefore a functional feature of the process, which conferred novelty over D2.

- d) The claimed process differed from the one of document D6 as the closest prior art in the addition of an ethoxylated fatty alcohol with 1 to 3 ethoxy groups at a certain weight ratio with the ethoxylated fatty alcohol with 4 to 20 ethoxy groups. The tests on compositions A to D in the patent showed that significantly better results in volume and body of hair were obtained when the two ingredients were used in combination than when used alone, so that the problem was the provision of a process for conditioning hair allowing to increase volume and body thereof. The solution involved an inventive step, as documents D1 and D3 did not point to the combination of the two ethoxylated alcohols in order to solve the posed problem.

- VI. Opponent 2 (appellant) lodged an appeal against that decision, contesting the findings of the opposition division as far as novelty and inventive step were concerned.
- VII. Opponent 1 also lodged an appeal, but later withdrew the opposition with letter of 18 January 2016.
- VIII. With the reply to the statements of grounds of appeal dated 30 October 2014 the patent proprietor

(respondent) filed four sets of claims as auxiliary requests 1 to 4.

- IX. In a communication sent in preparation of oral proceedings, the Board summarised the points to be dealt with, and provided a preliminary view on novelty and inventive step.
- X. Oral proceedings were held on 21 January 2016.
- XI. The arguments of the appellant, as far as relevant to the present decision, can be summarised as follows:

*Main request - novelty*

- a) Compositions A and B on page 66 of document D2 had all the features of the composition used in the process of claim 1 of the main request. It was clear from the introductory part of the description and in particular from the passages on pages 3 and 4 that the compositions of D2 were meant to obtain conditioning benefits, including increasing body and volume of hair. While it was correct that body and volume referred to different properties, the former being related to a tactile feeling and the latter to a visual one, both of them were meant by means of the feature indicated in D2 ("die Fülle des Haares"). These considerations applied to compositions A and B of document D2, whose use as conditioning compositions necessarily comprised the process steps of claim 1 including an application of 1 to 20 minutes. In view of that, the process of claim 1 lacked novelty over D2.

*Main request - inventive step*

b) The process of claim 1 of the main request differed from the disclosure of D6, which represented the closest prior art, in particular from its example IV, in that an ethoxylated fatty alcohol with 1 to 3 ethoxy groups was used instead of Coleth 24. Indeed, there was no doubt that body of hair was disclosed with relationship to the compositions of D6. No improvement was shown by the examples in the patent, which did not provide a comparison with D6, did not provide detail of how the panelists had been chosen and did not support the presence of a synergy between the two ethoxylated fatty alcohols, as a double quantity was present in composition D when compared to compositions B and C. The problem was therefore the provision of an alternative over D6. The use of an ethoxylated fatty alcohol with 1 to 3 ethoxy groups in combination with one with 4 to 20 ethoxy group was obvious, as it was known in the field to use these alcohols (e.g. from D1) and to combine ethoxylated fatty alcohols with different degrees of ethoxylation (e.g. from D2 and D4). Moreover, the skilled person would consider to replace Coleth 24 with a compound with a similar structure. In any case, ethoxylated products always contained different degrees of ethoxylation. In view of that, the process of claim 1 of the main request did not involve an inventive step.

XII. The arguments of the respondent, insofar as relevant to the present decision, can be summarised as follows:

*Main request - novelty*

- a) There was no disclosure in D2 of the use of compositions A and B on page 66 for improving body and volume of hair. The two properties were different, the former relating to what was felt with the hands and the latter to what was seen with the eyes and document D2 did not disclose any of the two in relationship to the relevant compositions. The cited passages did not relate to the specific compositions and nowhere a disclosure was present of an improvement in both body and volume being obtained or even aimed at. As the feature was a functional feature of the process, it rendered the process novel with respect to the disclosure in D2.

*Main request - inventive step*

- b) Example IV of D6, which represented the closest prior art, disclosed the use of a composition comprising Laureth-4 (an ethoxylated fatty alcohol with 4 ethoxy groups) and Coleth 24 (cholesterol ethoxylated with 24 ethoxy groups). In addition, it mentioned that the disclosed compositions were employed to add body to the hair (among other effects). However, it did not disclose compositions including a second ethoxylated fatty alcohol with 1 to 3 ethoxy group, nor the improvement of body and volume of hair. The tests in the patent showed the synergy between the two ethoxylated fatty alcohols. The panelists had been chosen among possible users of the compositions, as is common practice, and the tests clearly showed that with one of the two alcohols no improvement was present, whereas both body and volume strongly improved, when the two were



combined. This had nothing to do with the quantities chosen and no counter-tests were present. The problem was therefore the provision of a process for increasing body and volume of hair and the solution was not obvious, as none of the cited documents disclosed these properties as related to the combination of ingredients in claim 1.

XIII. The appellant requested that the decision under appeal be set aside and the patent be revoked.

XIV. The respondent requested that the appeal be dismissed, or that the decision under appeal be set aside and the patent be maintained according to one of auxiliary requests 1 to 4 filed with the reply to the grounds of appeal dated 30 October 2014.

## **Reasons for the Decision**

### *Status of opponent 1*

1. Opponent 1 has withdrawn its opposition. This is to be seen also as a withdrawal of the appeal (G 8/93, OJ EPO 1994, 887). By virtue of this, opponent 1 is no longer a party to the proceedings (see also Case Law of the Boards of Appeal, 7th edition 2013, IV.C.4.1.2).

### *Main request - novelty*

2. While it is not disputed that examples A and B on page 66 of document D2 (comprising Laureth-2, Trideceth-10, Trideceth-5 and guar hydroxypropyltrimonium chloride) discloses compositions falling under those used in the process of claim 1 of the main request, the critical

question is whether these compositions are disclosed in a process for improving body and volume of hair.

- 2.1 With regard to the defined purpose of the process ("for increasing body and volume of hair"), it is noted that the case law distinguishes claims directed to the use of a substance to achieve an effect from claims concerning the use of a substance to produce a product and considers that decisions G 2/88 (OJ EPO 1990, 93) and G 6/88 (OJ EPO 1990, 114) pertain to the first type of claims and are not to be applied to the second type, even if the achievement of an effect is defined therein (see case Law of the Boards of Appeal, 7th edition 2013, I.C.6.3.1 e)). In spite of the formulation of claim 1 of the main request as a process claim, it is related to the application of the composition and not to its production, so that the claim concerns the use of the defined composition to achieve an effect ("increasing body and volume of hair") and this effect is to be considered as a functional technical feature of the claim.
  
- 2.2 As to the question whether this feature has been disclosed in D2 in relationship to the use of compositions A and B on page 66, reference was made to the passages on pages 3 (first and second full paragraphs) and 4 (last full paragraph).
  
- 2.2.1 The first citation belongs to the introductory part of the description relating to the prior art and lists a number of properties which may be of interest when applying cosmetic care products to hair which underwent a hair treatment, including among others the optimisation of stability and fullness of the hair ("der Halt und die Fülle des Haares").

- 2.2.2 This citation discloses therefore properties which may be of interest for cosmetic care products, but has no relationship to the specific compositions which are the object of D2 and therefore it does not relate to the specific examples therein.
- 2.2.3 Moreover, it was agreed by the parties that body and volume of hair are two distinct properties, the former being related to a tactile feeling ("what you feel with your hands") and the latter to a visual one ("what you see with your eyes"), so that the disclosure of one does not imply the disclosure of the other, and the passage on page 3 referring to the fullness of the hair ("die Fülle des Haares") can be seen at most as a disclosure of body of hair, but does not relate to volume.
- 2.2.4 As to the disclosure on page 4, while it indeed related to the properties of the compositions claimed in D2, it lists combability, gloss and elasticity, but neither mentions body, nor volume of hair.
- 2.3 In view of this, no disclosure is to be found in document D2 of the functional feature of the process of claim 1 of the main request in relationship to the compositions disclosed therein (in particular compositions A and B on page 66), so that novelty with respect to document D2 must be acknowledged.

*Main request - inventive step*

3. There was no dispute between the parties that document D6 is the closest prior art, that its example IV (column 5, lines 10 to 30; see in particular Polyquaternium-10 and Laureth-4 and their quantities) discloses a composition comprising all the ingredients

of the composition used in the process of claim 1 of the main request in the foreseen quantities apart from an ethoxylated fatty alcohol with 1 to 3 ethoxy groups and that improvement of the body of hair is one of the objectives of the compositions disclosed in D2 (column 2, line 8 to 12 and 21 to 27). The Board agrees with this analysis.

- 3.1 As to the differences between the process of claim 1 of the main request and the disclosure in D6, the Board, however, finds that, in addition to the presence of an ethoxylated fatty alcohol with 1 to 3 ethoxy group in a certain weight ratio to the other ethoxylated fatty alcohol, the improvement of the volume of hair is a further distinguishing feature.
- 3.2 In this respect, it is noted that body and volume of hair are two different properties (see point 2.2.3, above) and only the former is disclosed in D2, while an improvement of the latter is not derivable from the document.
- 3.3 The Board is satisfied that the tests available in the patent show that the combination of the two ethoxylated fatty alcohols results in an improvement in both properties.
  - 3.3.1 While it is true that the total quantity of ethoxylated fatty alcohols in composition D of example 1 in the patent is twice as big of the quantity in compositions B and C (see paragraph [0073]), the results clearly show that with only one of the two ethoxylated fatty alcohols at 1% by weight no improvement in body and volume is obtained, while, when 1% of each is employed, a strong improvement in both body and volume is present (table 1 in paragraph [0074]).

- 3.3.2 The improvement cannot be uniquely attributed to the higher overall quantity, as, if only the presence of the ethoxylated fatty alcohols independently of the mixture were relevant, an improvement (even if at a lesser extent) should appear also for compositions B and C.
- 3.3.3 As to the choice of the panelists, the Board sees no reason to doubt that the chosen volunteers, as females having declared to have volume and/or body problems (paragraph [0074]), were able to judge the results of the application of the tested compositions.
- 3.3.4 On top of that, no counter-tests have been provided by the appellant to show that the results are not reliable or that the improvements are not obtained.
- 3.4 In view of the identified differences and the results in the tests, the problem solved is therefore the provision of a process which employs an alternative composition to improve the body of hair and to provide an additional beneficial effect.
- 3.5 None of the cited prior art documents provides a hint that by means of the combination of the two ethoxylated fatty alcohols an alternative way of improving body of hair is achieved and additionally also the volume of hair is improved.
- 3.5.1 Document D1 discloses in its examples (pages 35 to 37) a C<sub>12-14</sub> fatty alcohol with 2.5 ethoxy groups (see ingredient Arylpon® 7 on page 35 and explanation on page 36, point 7, making reference to Laureth-2) as an ingredient of shampoo compositions. Nothing is said on

- its combination with other ethoxylated fatty alcohols, nor on possible effects on the body and volume of hair.
- 3.5.2 Document D4 discloses in its examples 1 to 4 (columns 7 and 8) conditioners with two ethoxylated fatty alcohols with different degrees of ethoxylation (Steareth-2 and Steareth-21). However, also in this case nothing is said on possible effects on the body and volume of hair.
- 3.5.3 As to document D2, apart from the fact that it does not belong to the state of the art under Article 54(2) EPC (see the filing and publication dates in points I and III, above), the analysis of the document outlined in the discussion of novelty makes it clear that the combination of ethoxylated fatty alcohols is not disclosed therein in relation to a possible improvement of the body and volume of hair (see point 2.2, above).
- 3.5.4 As to the possible replacement of Coleth 24 (present in the compositions of D6, see e.g. example IV) with a compound with a similar structure and to the presence of ethoxylated fatty alcohols with different degrees of ethoxylation in any alcohol of this kind, these measures are in any case not sufficient to come to the claimed process, as no information of an improvement in volume of hair is available in D6. Moreover, the former measure is not suggested anywhere and, as to the latter issue, there is no information available on file as to the possible quantities of alcohol with different degrees of ethoxylation in ethoxylated fatty alcohols.
- 3.6 As no hint is to be found in the available prior art that the missing features should be added to the disclosure of D6 in order to solve the posed problem,

the process of claim 1 of the main request involves an inventive step.

### *Conclusions*

4. The Board has come to the conclusion that the parts of the decision under appeal which have been contested by the appellant, namely those concerning novelty and inventive step, hold good. As other parts of decision were not contested, there is nothing more to be decided upon and the appeal is to be dismissed.

### **Order**

#### **For these reasons it is decided that:**

The appeal is dismissed

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated